IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application for:	
Gary Johnson	Examiner: STEVEN B. THERIAULT
Serial No.: 10/686,990	Art Unit: 2179
Filing Date: 10/15/2003	
For: APPLICATION OF SPEED EFFECTS TO A VIDEO PRESENTATION	

PRE-APPEAL REMARKS

Appellant respectfully submits that the claims should be allowed for numerous reasons including the following three. *First*, the Office Action and Advisory Action ("Actions") do not address some elements of some of the claims at all. *See*, e.g. "providing the video clip as individual frames to the video editing application at a rate based on the speed effect settings." in sect. IV. *Second*, the Actions and the previous Non-final Office Action do not directly address the element of dragging a graph to specify speed effects, despite the fact that the element was present in the original claims. *See*, e.g. sect. II. *Third*, the Actions do not provide a valid reason why it would be obvious to combine the references. *See*, sect. I.B. These reasons are elaborated below.

I. REJECTION OF CLAIMS 1-13 UNDER 35 U.S.C. § 103(a)

A. Cited references do not show all limitations or render them obvious

Claim 1 was rejected over Kanda in view of Fayan. Claims 2-13 depend from claim 1. Claim 1 recites (among other things) receiving a set of speed effects for a video clip through a set of modifications of a user selectable graph. The Office Action states that Fayan discloses receiving a set of speed effects for a video clip though a set of modifications of a user selectable graph. However, Fayan does not disclose this.

Fayan teaches the computer modifying a graph as an effect of receiving speed effects; it does not teach receiving modifications of a user selectable graph as a way to receive speed effects. Fayan allows keyframes to be selected, but the keyframes of Fayan are not frames of a clip, but are particular fixed output times. Fayan does not teach that keyframes or any other part of the graph is movable by the user. Fayan teaches that speed effects are received by entering values for the speed for a given output time. Fayan teaches that the graph is interpolated from the entered values for the

speeds at given output times (e.g. changes to the graph are a side effect of edits elsewhere). Therefore, Fayan does not receive its speed effects through modification of the graph as claim 1 does. Accordingly, even the piecemeal, hindsight combination of Fayan and Kanda does not render claim 1 obvious.

B. Combination is not obvious & Kanda teaches away from combination

The reason given in the Advisory action misinterprets Fayan and is equivalent to stating that the combination is obvious because limitations of the claims that are missing from one reference are present in another. However, the question of whether Kanda could properly be modified in a §103(a) rejection is not whether a particular limitation was known, but rather whether there is a reason that would make it obvious for one of ordinary skill in the art at the time of the invention to modify Kanda to include that particular limitation. The Actions must identify a reason why it would have been obvious to combine the cited references. Furthermore, this reason would have to be obvious at the time of filing of the application. That is not the case here.

The Advisory Action misinterprets Fayan's "editor". The Advisory Action states that the suggestion to combine comes from paragraph 29 of Fayan which says that a "user interface [with graphs] may be made available to an editor if an editor selects a retiming effect to be applied either to source material or to a clip on the timeline." The Examiner cites this as Fayan "expressly suggesting the combination". However, the "editor" that Fayan discloses is the person using the system of Fayan, not a video editing system. Fayan uses the word "editor" exactly twelve times, each time in a context that demonstrates that the "editor" is the user, not the application. Accordingly, Appellants respectfully submit that Fayan is not suggesting that the graphs of Fayan can be combined with any application, only that the system of Fayan makes this interface available to users. Accordingly, the argument that this is an express suggestion to use the graphs of Fayan in Kanda is equivalent to stating that the combination is obvious because the elements are known, which is not allowed in a valid rejection. Furthermore, a generic statement that some video editors have graphs like Fayan would not be enough to meet the prima facie burden of showing obviousness; the Actions must show that it would be obvious to combine the graphs of Fayan with Kanda, not merely that some video editors use graphs. Furthermore, there is nothing in Fayan to indicate that the existence of a timeline in a program would make the graphs of Fayan obvious to combine with Kanda, which already had a different method of indicating timing and speed of clips.

In fact, Kanda's method actually teaches away from using graphs to indicate speed of clips. Kanda and Fayan each disclose separate and distinct inventions that have their own methods of doing things. Kanda has a method of indicating timing and speed of clips, for example, see the

running man icon 25ga of Kanda, Figure 13. The tiny space that the speed indicator of Kanda takes up teaches away from combining Kanda and the much larger graphs of Fayan as doing so would crowd out other functionality of Kanda, meaning that it could not function as designed. *See* Kanda, Figs. 3-4 item 25 for proportional size of item 25 to full GUI and Kanda, Fig. 13 item 25g for the space the actual speed indicator takes up, i.e. approximately 10% of the area of item 25.

It cannot be obvious to modify a reference in a way that renders it unable to perform its designed functions. As indicated above, modifying Kanda to include the graphs of Fayan in a way that would anticipate claim 1 would render Kanda unable to perform its designed functions. Accordingly, modifying Kanda to include the graph of Fayan would mean changing a known, working system to a different system without anything that would make it obvious to one of ordinary skill in the art that the different system would work.

II. REJECTION OF CLAIMS 20-32, 36-40, AND 51-64 UNDER 35 U.S.C. § 103(a)

Claim 20 was rejected over Kanda in view of Fayan. Claims 21-32 and 36-40 depend on claim 20. Claim 51 was rejected on the same rationale as claim 20 and claims 52-64 depend from claim 51. Claim 20 recites (among other things) allowing a user to specify a speed effect for the video presentation by selecting and modifying a portion of the graph through a GUI drag operation.

Appellant respectfully submits that the combination of Kanda and Fayan does not render claim 20 unpatentable because it does not provide or render obvious every element of claim 20. For example, neither Kanda nor Fayan discloses, teaches, or even suggests modifying a graph of a playback time relative to a content time of a video presentation by selecting a portion of the graph and performing a GUI drag operation. The Office Action cites Kanda as teaching allowing the user to drag events, however, the events of Kanda are not the graph of claim 20. The dragging operations of Kanda, cited as teaching this limitation do not modify a graph at all. In contrast, claim 20 recites allowing a user to modify the graph by selecting a portion of the graph and performing a GUI drag operation. Accordingly, the Office Action does not address all the limitations of the claim. Furthermore, as explained in detail in sect. I.B., the Actions do not provide a valid reason why it would be obvious to combine the references.

III. REJECTION OF CLAIMS 41-50 UNDER 35 U.S.C. §101

Claim 41 recites a graphical user interface. Claims 42-50 depend on claim 41. Appellant respectfully submits that the graphical user interface of claim 41 is not non-statutory. The MPEP does not rule out all computer programs as non-statutory. The MPEP provides that:

> When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.

MPEP § 2106.01

Furthermore, §101 states that "[w]hoever invents… any new and useful improvements [of a process, machine, manufacture, or composition of matter] may obtain a patent therefore". The Office Action states that "the language of the claims raise (sic) a question as to whether the claims are directed to an abstract idea that is not tied to a technological art, environment, or machine". Appellant respectfully submits that a GUI, by its very nature, is tied to a machine. In particular, a GUI is tied to the display(s) and user interface devices of the machine. Therefore, a new and useful GUI is a "new and useful improvement of a machine". In fact, the description given by the Patent Office for the 2170 family of art units is "Graphical User Interfaces".

Appellant respectfully submits that the GUI of claim 41 bears out this connection to a display and user interfaces, as it specifically recites a display area for displaying a video presentation and a selectable GUI graph representing the playback-time of the video presentation relative to the content-time of the video presentation, where a speed effect is specified by selecting and modifying the graph. Therefore, the GUI is an improvement of an existing machine and thus statutory. Accordingly, Appellant respectfully requests that the Examiner withdraw the § 101 rejection of claims 41-50.

IV. REJECTION OF CLAIMS 65-67 UNDER 35 U.S.C. § 103(a)

Claim 65 was rejected over Kanda in view of Fayan. Claims 66-67 depend, directly or indirectly from claim 65. Claim 65 recites (among other things) providing the video clip as individual frames to the video editing application at a rate based on the speed effect settings.

The Actions do not address the limitation of "providing the video clip as individual frames to the video editing application at a rate based on the speed effect settings." Neither Kanda nor Fayan nor their combination disclose, teach, or suggest such a limitation. Furthermore, as explained in more detail in sect. I.B., there is no reason why it would have been obvious to combine Fayan and Kanda.

Accordingly, Appellant respectfully submits that the combination of Kanda and Fayan does not render claim 65 unpatentable. As claims 66-67 are dependent, directly or indirectly on claim 65, Appellant respectfully submits that claims 66-67 are patentable over Kanda for at least the same reasons that claim 65 is. In view of the foregoing, Appellant respectfully requests reconsideration and withdrawal of the §103(a) rejections of claims 65-67.

V. REJECTION OF OTHER CLAIMS UNDER 35 U.S.C. § 103(a)

Many of the other independent and dependent claims are patentable over the cited references for reasons similar to those cited above. Brief arguments for only some of these additional claims will be provided in the interest of space, the arguments below are examples and are not the sole reasons the claims are patentable. The method of claim 6 allows a user to select a portion of the graph and move the selected portion of the graph. Nothing in Kanda or Fayan suggests this. The Examiner cites Kanda's "dragging events" (which doesn't affect speed effects) as disclosing this. However, claim 6 recites moving a selected portion of a graph and (in antecedent claims) modifying the speed effects by modifying the graph. Claim 17 has similar limitations. Claim 41 has a display area not found in Fayan, a graph not found in Kanda and its dependent claim 42 has a drag operation not disclosed or made obvious by either. Claim 14 has graphs not found in Kanda and realtime display not found in Fayan. Claim 14 and all the claims (1-67) are valid for at least the lack of an obvious reason to combine the cited references. Many claims not specifically cited are valid for similar reasons or for other reasons. Accordingly, Appellant respectfully requests reconsideration and withdrawal of the rejections of claims 1-67.

CONCLUSION

In view of the foregoing, it is submitted that all the claims, namely claims 1-67 are in condition for allowance. Reconsideration of the rejections is requested. Allowance is earnestly solicited at the earliest possible date.

Respectfully submitted,

ADELI & TOLLEN LLP

Dated: March 14, 2008

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): APLE.P0060

I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and trademark office

on 03/14/08

Signature /Adam Littman/

Typed or printed name Adam Littman

Application Number	Filed
10/686,990	10/15/2003

First Named Inventor: Gary Johnson

Art Unit	Examiner
2179	Steven B. Theriault

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____.
- ☒ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 61,014

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03/14/08
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.